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SR

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/970,258	11/14/97	SLIFER	R

QM12/0117

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EXAMINER	
HARRISON, J	
ART UNIT	**PAPER NUMBER**
3713	# 12

DATE MAILED: 01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/970,258	Slifer
Examiner	**Group Art Unit**
J. Harrison	3713

☒ Responsive to communication(s) filed on *Oct 26, 2000*.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-18* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-18* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Acknowlegement is made of Applicant's Appeal Brief, filed October 26, 2000. After review and conference, it has been decided that the application contains outstanding issues and accordingly prosecution on the merits is being reopened. The delay in presenting these grounds of rejection is regretted.

Claim Rejections - 35 USC § 112

Claims 1-8 and 16- 18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the amendment of February 17, 2000, introduced new matter into the claims with the language of claim 1 "wherein the processor unit authorizes game execution based on the user age" and of claim 16 "authorizing operation of a video game based upon the user age".

The original specification merely states on page 5 "by including the age of a user, it will be appreciated that amusement games designed for a specific age group is not operated by an inappropriate user". Clearly such does not support the specific language or scope of the amendatory claim language.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant specification is deficient with respect to several points. First, applicant's specification fails to enable how the personalized data is input into the portable controller. It is merely stated that "the controller can be updated via the CPU and selections presented on the video screen". No further explanation is given. No description of how the CPU accomplishes this function, nor any discussion of communications protocols between the CPU and the portable controller are seen. Where does the software for accomplishing this function reside? Is it permanently stored in the game unit, or is it part of the game being executed by the unit? Without any mechanism for entering personalized information into the portable controller, it is unclear how the system can operate as claimed.

Secondly, it is unknown how the processor unit authorizes game execution based upon the user age. No discussion is given for any modifications to the processor unit. No discussion is seen for any modifications to the game software. It appears as though applicants personalized controller is intended to work with existing game systems. However, it is clear that if this controller were utilized with a conventional system, the personalized data (assuming arguendo the information could be entered into the controller) being transmitted would be completely ignored by the game system, as the information would have no meaning to the system. Further, claim 3 recites wherein the user information stored in the memory of the processor unit is retrieved for

use by the processor unit in response to the identification signal transmitted by the personal portable controller. It is not seen where this is disclosed or discussed in the specification.

Clearly, the instant specification only tells half of the story; what modifications are made to the control unit and corresponding game software in order for the system to function? The broad brush strokes of what the personalized controller can do and functional descriptions of possible operations given are an invitation to experiment and insufficient in enabling one of ordinary skill in the art to practice the invention without undue experimentation.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the claimed phrasings of "historical game performance data", "historical performance data", and "video game operating preferences" are not seen in the specification. Applicant must use consistent terminology throughout the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson et al (Lem).

At the onset it is noted that applicants specification teaches at 3:38 " it should be noted that the term video game, as used herein, refers to interactive video systems displaying images for amusement *or education*. Video game, therefore, should not be interpreted as limited to amusement systems." Accordingly, Lem is clearly analogous art. The rejection in the prior office action is maintained. Note Lem's teaching of identifying **the student** or the input device which in turn identifies the student at 1:59. As previously set forth, age would be an obvious student identifier. Further, note Lem 5:59 - 66, at least, where the memory 31 stores student responses prior to transmission (performance data).

Due to the new grounds of rejection contained herein, this action is not made final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Harrison whose telephone number is (703) 308-2217.

JESSICA J. HARRISON
PRIMARY EXAMINER

jjh

January 14, 2001

ATTACHMENT TO AND MODIFICATION OF NOTICE OF ALLOWABILITY (PTO-37)

(November, 2000)

NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored[1]:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

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[1] The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "*Changes to Implement the Patent Business Goals*", 65 *Fed. Reg.* 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 *Off. Gaz. Pat. Office* 77, 99, 110, 135, 139 (September 19, 2000).